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Thomas E. Murphy

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One AT&T Way

Bedminster, NJ 07921

EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2424

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/026,704	<b>Applicant(s)</b> MURPHY ET AL.	
	<b>Examiner</b> MICHAEL VAN HANDEL	<b>Art Unit</b> 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 6/23/2009. Claims **30-37** are pending. Claim **32** is amended. Claims **1-29** are canceled. Claims **33-37** are new.

### ***Response to Arguments***

2. Applicant's arguments regarding claims **30** and **32**, filed 6/23/2009, have been fully considered, but they are not persuasive.

Regarding claim **32**, the applicant argues that DeWeese et al. does not teach receiving broadcasted content from a service provider via a first input, processing the broadcasted content by a processor for display via a first output, conducting two-way communications with other devices via a back channel communications path at an input-output port, and receiving a communication at the input-output port. The examiner respectfully disagrees. Applicant specifically argues that DeWeese et al. explains that both programming and chat messages are sent along the same communications path. The examiner first notes that the features upon which applicant appears to rely (i.e., that the programming and chat messages are sent via different communications paths) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As currently claimed, the language of claim 32 does not distinguish the first input and the input-output port as being different separate communication paths.

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Even if they were claimed as being different; however, DeWeese et al. teaches that the television content and messages are sent via different communication paths. As noted in the Office Action mailed 12/31/2007, DeWeese et al. discloses a television chat system 10 as shown in Figure 1A. Communication paths 24 have sufficient bandwidth to allow television distribution facility 16 to distribute scheduled television programming, pay programming, real-time communications, chat requests and other video and audio information to user television equipment 20 in addition to non-video program guide information and communications. The real-time communications supported by communication paths 24 may be text-based or, if more bandwidth is available, may be audio or video communications (p. 3, paragraph 55). DeWeese et al. also discloses that the communications paths 24 have two-way digital channels for supporting real-time communications (p. 3, paragraphs 55-56). Real-time communications and chat requests are distributed along communication paths from one user television equipment device 20 associated with a given television distribution facility 16 to another user television equipment device 20 associated with that facility using a chat server located at the facility (p. 5, paragraph 71 & Fig. 2A). DeWeese et al. further discloses that each of the communications paths include a number of traditional analog television channels, as well as two-way digital channels that support the two-way real-time communications between set-top boxes (p. 3, paragraph 56). Since the real-time communications are sent on a logically separable path over the coaxial cable and further since multiple set top boxes are connected to the set top box by way of television distribution facilities and chat servers (Figs. 1A, 2A, 2B, 3, 10), the examiner interprets the reception of the TV programming over the analog channels and the reception of the message information over the digital channels as different paths. The examiner further notes that

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the real-time communications of DeWeese et al. are distributed by way of television distribution servers and chat servers to other homes coaxial cable networks (Figs. 1A, 2A, 2B, 3, 10). This is also a different communication path than that used to distribute the TV content, in that it includes the path to the second set-top box as well.

Regarding claim **30**, the applicant argues that DeWeese et al. does not teach receiving broadcasted content from a service provider via a first input, sending the broadcasted content to the television via a first output, and conducting two-way communications with other devices via a back channel communications path at a second output of the set top box. The examiner respectfully disagrees. Applicant specifically argues that DeWeese et al. sends both programming and chat messages along the same communications path. As noted above with respect to claim 32, the current claim language does not reflect that first input and second output are separate communications path. Even if they were claimed as being separate; however, they would still be taught by DeWeese et al. for the reasons stated above with respect to claim 32.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims **32-37** are rejected under 35 U.S.C. 102(e) as being anticipated by DeWeese et al.

Referring to claim **32**, DeWeese et al. discloses a method, comprising:

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- receiving broadcasted content from a service provider via a first input (p. 3, paragraph 56);
- processing the broadcasted content by a processor for display via a first output (p. 4, paragraph 65; p. 8, paragraph 93; & Figs. 1A, 9);
- receiving message information from a user via a second input (p. 5, paragraph 67; p. 9, paragraphs 101, 105; & Figs. 1B, 10);
- conducting two-way communications with other devices via a back channel communications path at an input-output port (p. 3, paragraph 57; p. 4, paragraph 59; & p. 5, paragraphs 71-73); and
- receiving a communication at the input-output port (p. 8, paragraph 93 & Fig. 9).

Referring to claim **33**, DeWeese et al. discloses the method according to claim 32, further comprising retrieving a visual representation from memory that corresponds to a sender of the communication (user nickname or icon)(p. 6, paragraph 76; p. 7, paragraph 85; & p. 8, paragraphs 93, 95).

Referring to claim **34**, DeWeese et al. discloses the method according to claim 32, further comprising retrieving a picture from memory that corresponds to a sender of the communication (user nickname or icon)(p. 6, paragraph 76; p. 7, paragraph 85; & p. 8, paragraphs 93, 95).

Referring to claim **35**, DeWeese et al. discloses the method according to claim 32, further comprising retrieving a callout bubble from memory when the communication comprises text (text within chat room region)(p. 8, paragraph 93 & Fig. 9).

Referring to claim **36**, DeWeese et al. discloses the method according to claim 32, further comprising placing the text within the callout bubble (text within chat room region)(p. 8, paragraph 93 & Fig. 9).

Referring to claim **37**, DeWeese et al. discloses the method according to claim 36, further comprising processing for display the visual representation of the sender and the callout bubble comprising the text of the sender's communication (displaying user nickname or icon with text in chat room region)(p. 6, paragraph 76; p. 8, paragraphs 93, 95; & Fig. 9).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **30, 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over DeWeese et al. in view of Mimura et al., and further in view of August et al.

Referring to claim **30**, DeWeese et al. discloses a set top box integrated with, or communicating with, a television, the set top box comprising memory storing instructions for:

- receiving broadcasted content from a service provider via a first input (p. 3, paragraph 56);
- sending the broadcasted content to the television via a first output (p. 4, paragraph 65; p. 8, paragraph 93; & Figs. 1A, 9);

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- receiving message information from a user via a second input (p. 5, paragraph 67; p. 9, paragraphs 101, 105; & Figs. 1B, 10);
- conducting two-way communications with other devices via a back channel communications path at a second output of the set top box (p. 3, paragraph 57; p. 4, paragraph 59; & p. 5, paragraphs 71-73);
- retrieving a visual representation from the memory that corresponds to a sender of a communication (user nickname or icon)(p. 6, paragraph 76; p. 7, paragraph 85; & p. 8, paragraphs 93, 95);
- processing a callout bubble that places text of the communication within the callout bubble (text within chat room region)(p. 8, paragraph 93 & Fig. 9); and
- processing for display the visual representation of the sender and the callout bubble comprising the text of the sender's communication (Fig. 9).

DeWeese et al. also discloses receiving television audio channels (p. 3, paragraph 56; p. 4, paragraph 64; & p. 9, paragraph 102). DeWeese et al. further discloses transmitting video chat images with audio as real-time communications by the chat system (p. 10, paragraphs 107, 111 & Fig. 11). DeWeese et al. still further discloses that the video chat images and audio can be shown at the same time as a television program (p. 11, paragraphs 119, 120 & Figs. 16, 17).

DeWeese et al. does not specifically disclose that when the communication has audible content, the communication is processed for another audio channel and a volume of the broadcasted content is reduced below a volume of the communication being played. Mimura et al. discloses a television audio/visual (A/V) conferencing system with a database 12. The AV database stores combinations of video signal characteristics and corresponding audio signal processing



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parameters, such as a volume of sound to be reproduced and a balance between sounds reproduced by loudspeakers (col. 9, l. 10-35). The processing parameters are read from the database and supplied to an audio signal processor to control the sound field to produce an acoustic space suitable for an image, by changing the sound volume and right and left balance to localize sounds based on the locality of displayed images (col. 6, l. 13-23; col. 20, l. 22-62; & Figs. 32A-33). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the video and audio chat system of DeWeese et al. to include changing the sound volume and right and left balance of the received audio messages to be output from different speakers, such as that taught by Mimura et al. in order to provide a real-time TV conferencing system with improved reality (Mimura et al. col. 3, l. 36-45). The combination of DeWeese et al. and Mimura et al. does not specifically teach reducing a volume of the audio signal below a volume of the communication being played. August et al. discloses a set-top box 30 for receiving A/V and telephone signals. When a television viewer receives a telephone call over the set-top box, the audio signal emanating from the video receiving device can be automatically muted or reduced to a selectable level (col. 2, l. 46-64). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of DeWeese et al. and Mimura et al. to include reducing the volume of a television audio signal upon receiving an audio message, such as that taught by August et al. in order to provide the automatic interaction of desirable activities (August et al. col. 2, l. 56-68).

Referring to claim **31**, the combination of DeWeese et al., Mimura et al., and August et al. teaches a set top box according to claim 30, wherein the memory stores instructions for receiving signals from a keyboard input (DeWeese et al. p. 5, paragraph 67 & Fig. 1B).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/  
Supervisory Patent Examiner, Art Unit  
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MV